

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
)	
Fleckenstein, <i>et al.</i>)	Art Unit: 1614
)	
Application No. 10/528,684)	Examiner: Weddington, K.E.
)	
Filing Date: May 9, 2005)	Confirmation No. 4643
)	
For: MODULATING VESICULAR)	
MONOAMINE TRANSPORTER TRAFFICKING)	
AND FUNCTION: A NOVEL APPROACH FOR)	
THE TREATMENT OF PARKINSON'S DISEASE))	

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

NEEDLE & ROSENBERG, P.C.
Customer Number 23859

Sir:

Responsive to the Office Action mailed April 30, 2007 in regard to the above-referenced patent application, please consider the following remarks.

Remarks

Response to Restriction Requirement

In the Office Action mailed April 30, 2007, the claims were divided into 9 Groups:

- I. Claims 1-10 and 28, are drawn to a method for treating Parkinson's disease comprising administering to a subject a compound having formula 1;

- II. Claim 11 is drawn to a method for treating Parkinson's disease comprising administering to a subject d-threo methylphenidate;
- III. Claims 12-22 are drawn to a method for treating Parkinson's disease comprising administering to a subject a compound having formula IV;
- IV. Claim 23 is drawn to a method for treating Parkinson's disease comprising administering to a subject a compound having formula VII;
- V. Claim 24 is drawn to a method for treating Parkinson's disease comprising administering a subject a compound having formula VIII;
- VI. Claim 25 is drawn to a method for treating Parkinson's disease comprising administering to a subject a compound having formula IX;
- VII. Claim 26 is drawn to a labeled compound;
- VIII. Claim 27 is drawn to a method for treating anxiety, autism depression sexual dysfunction, hypertension, migraine, etc. with a compound from any one of the claims 1-25; and
- IX. Claim 29 is drawn to a pharmaceutical composition comprising formula I.

In response, applicants elect Group I, claims 1-10 and 28, with traverse. The Office Action also required that if Group I were elected, that one species also be elected. In response, applicants elect the species of claim 2 (Formula II) with traverse.

Applicant respectfully requests that the restriction requirement be reconsidered, as the Examiner has not shown that a serious burden would result if all the claims are examined together. M.P.E.P. § 803 provides that "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (*Emphasis added.*) Thus, for a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence

of independent and distinct inventions (35 U.S.C. § 121) and (2) the search and examination of the entire application cannot be made without serious burden. *See* M.P.E.P. § 803. Applicant notes that the restriction requirement does not provide sufficient basis to indicate that examination of more than one of the “groups” would overly burden the Examiner. Applicant thus respectfully requests reconsideration of the election requirement.

Applicant also respectfully requests that the requirement for species election be reconsidered, as the Examiner has not shown that a serious burden would result if all the species are examined together. M.P.E.P. § 803 provides that “[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” (*Emphasis added.*) Thus, for a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121) and (2) the search and examination of the entire application cannot be made without serious burden. *See* M.P.E.P. § 803. Applicant notes that the restriction requirement does not provide sufficient basis to indicate that examination of more than one of the “species” would overly burden the Examiner. Applicant thus respectfully requests reconsideration of the election requirement. In addition, as each of the species listed in claims 2 and 3 properly fall within the elected genus (see

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above), Applicant reminds the Examiner that if the elected genus is found to be allowable, all of the species listed in claims 2-3 should also be found allowable.

Favorable consideration of claims 1-29 is earnestly solicited.

No fees are believed due. However, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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/Janell T. Cleveland/
Janell T. Cleveland

5/18/200
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